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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/945,667	01/28/98	HORROBIN	D 34237/170943

EXAMINER	ART UNIT	PAPER NUMBER
HM42/0122	1613	7

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DATE MAILED: 01/22/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 27 TO 92 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 27 TO 92 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.
☐ received in Application No. (Series Code/Serial Number) _____.
☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892
☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Receipt is acknowledged of the preliminary amendment filed January 29, 1998 and December 23, 1998, which have been entered in the file.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Insertion of the following sentence as the first sentence on page 1 of the specification is required:

This application is a 371 of PCT/ / filed.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 27 to 92 are rejected under 35 U.S.C. 112, first and second paragraphs, for failing to properly define the invention.

The expressions "which may be", "the residue of", "a nutrient, drug or other bioactive compound", "residue", "nutrient", "drug", "bioactive compound", "further comprising", "or other barrier", "additive to or complementary to or synergistic with", "or derivatives thereof", "nonsteroidal antiinflammatory drugs....proton pump inhibitors... hypolipidaemic agent... pr bacteriochlorin-based drug", "fibrates", "stations", "diatrivate compounds", "inflammatory and auto-immune diseases other than arthritis.. Degenerative diseases of the eye... disorders...disorders, other learning disabilities... cancer cachexia", "allergic disorders "a food, nutritional supplement" and "food additives" render the claims indefinite and based on an inadequate or insufficient disclosure by placing no definite limits or boundaries on the claims, by being so broad as to read on subject matter as to which the disclosure is not enabling, and by being inadequately or insufficiently described in the written description of the specification.

Moreover, the expressions cover vast numbers of compounds many of which are not adequately described nor enabled by for the full scope thereof especially with regard to starting materials, precise reaction conditions, and so on.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 27 to 56, drawn to compounds and compositions, classified in class 548, subclass various, depending upon chemical structure of the elected species.

II. Claims 57 to 92, drawn to method of treating a disorder, classified in class 514, subclass various depending upon chemical structure of the elected species.

The inventions are distinct, each from the other because:

Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as the products as claimed may be used as in a plurality of materially different uses: e.g. in treating various diseases and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II or vice versa, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentability distinct species of the claimed invention the various species encompassed by the broad terminology encompassed by "the residue of a nutrient, drug or other bioactive compound of disorders in claim 27.

Upon election of a group (I or II above) applicant is further required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to non generic claim is finally held to be allowable. Currently, claim 1 is generic for Group I and claim 57 is generic Group II.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of al claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Chaudhari et al., Condi et al., Miyamoto et al., Breuseh et al., Langen et al., Lion Corp., Vajdi et al. and Watanabe et al., cited show the state of the art.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Floyd d. Higel whose telephone number is (703) 308-4530. The examiner can normally be reached on Tuesday to Friday from 8:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached on (703) 308-4532. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556. 7921

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

F. Higel:jmr

Jan. 15, 1999

Floyd D. Higel

FLOYD D. HIGEL
PATENT PRIMARY EXAMINER
ART UNIT ~~123~~ 1613